



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

GARLICK HARRISON & MARKISON  
P.O. BOX 160727  
AUSTIN, TX 78716-0727

COPY MAILED

OCT 15 2004

OFFICE OF PETITIONS

In re Application of  
Ba-Zhong Shen et al  
Application No. 10/669,066  
Filed: September 23, 2003  
Attorney Docket No. BP3036

:  
: DECISION ON PETITIONS  
: UNDER 37 CFR 1.78(a)(3)  
: UNDER 37 CFR 1.78(a)(6)  
:

This is a decision on the petition under 37 CFR § 1.78(a)(3), filed August 25, 2004, which is being treated under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed nonprovisional and provisional applications, the amendment of which is embodied in the instant petition.<sup>1</sup>

The petition is DISMISSED.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1).

---

<sup>1</sup> Petitioner is advised that the amendment must be included in a separate paper, since different matters are handled by different branches of the Office. Note 37 CFR 1.4(c) and 37 CFR 1.121.

The claim for benefit of the prior-filed applications cannot be accepted at this time. In this regard, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/—, filed —" (inclusion of the title of the invention of each application is not necessary). See Manual of Patent Examining Procedure (8<sup>th</sup> ed., August 2001), Section 201.11, Reference to First Application.

In reviewing the chain of applications to which applicants are seeking to claim priority, it does not appear that petitioner has complied with MPEP Section 201.06(d). The amendment submitted with the instant petition cannot be entered since the relationship of each application to the other is not clearly stated to which priority is being claimed. More specifically, as an example, the amendment states that the present application claims priority to U.S. Provisional Patent Serial No. 60/384,698, filed May 31, 2002..., U.S. Provisional Patent Serial No. 60/478, 690, filed June 13, 2003..., is a CIP of 10/264,486, filed October 4, 2002.... The instant application cannot claim direct priority to U.S. Provisional Patent Serial No. 60/384,698, since the present file was filed after the 12 months of the Provisional Patent Serial No. 60/384,698. Therefore, petitioner must review the chain of applications and ensure that compliance with 35 U.S.C. §§ 120 and 119(e) has been met and, further, must clearly set forth the relationship of each application to the earlier-filed application (i.e., use "which" and "and" to denote the proper relationship between each prior-filed and intermediate application). The amendment as written is unclear as to the relationship of the subject application to the other prior-filed and intermediate applications set forth in the amendment. Petitioner should also note that the prior-filed application must have a filing date earlier than the date of the application claiming the prior-filed application.

Accordingly, before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and a substitute amendment clearly stating the relationship of the prior-filed applications to the instant application is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop PETITIONS

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

By hand: Customer Window located at:  
U.S. Patent and Trademark Office  
220 20<sup>th</sup> Street S  
Customer Window, Mail Stop Petitions  
Crystal Plaza Two Lobby, Room 1B03  
Arlington, VA 22202

By fax: (703) 872-9306  
ATTN: Office of Petitions

The Change of Correspondence Address filed August 25 ,2004 is noted and made of record.

Any questions concerning this matter may be directed to Wan Laymon at (571) 272-3220.



Frances Hicks  
Lead Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy